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EXAMINER	
PHAN, HUY Q	

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/589,217	COOPER, DAVID	
	Examiner	Art Unit	
	HUY PHAN	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 February 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *28,29,32 and 33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *28, 29, 32 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Amendment filed on date: 02/25/2010.

Claims 28, 29, 32 and 33 are still pending.

Response to Arguments

2. I) Applicant has filed a timely terminal disclaimer (see Terminal Disclaimer Approval on 03/22/2010), the double patenting rejection is withdrawn.

II) Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "Sturniolo does not teach or suggest a method by which the mobile terminal determines a new access point with which to register (see REMARKS page 3)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Sturniolo discloses the process of registration when a mobile station roams from one network to another network (see fig. 2, steps 52 and 74). One of ordinary skill in the art would understand that the mobile station determines the network in order to register with it. Since, Sturniolo specifically suggests that "the mobile terminal 36 newly registers with the access point AP2"; therefore, Sturniolo discloses the features (see 9 lines above) which applicant argued in the case the features being claimed.

Applicant argued that "Sturniolo does not teach or suggest a mobile device receiving a message informing the device that one or more network identifiers are available for potential handover" (see REMARKS page 3). The examiner respectfully disagrees with applicant's argument. Sturniolo discloses a method of handover wherein the mobile station is ongoing communication with the first network and the mobile station roams from first network to the second network ("mobile terminals 36 also seamlessly roam from one network to another network without a need to terminate and reestablish an end to end session between the mobile terminal 36 and a device coupled to one of the networks" see col. 6, lines 39-43). So when the mobile station moves outside the coverage of the first network and moves into the coverage of the second network, one of ordinary skill in the art can understand that the mobile station would not know it's ongoing communication can be continuous unless the second network is available and allows the mobile station to register with it. Since Sturniolo specifically suggests that "the mobile terminal 36 receives a new network identification" (see col. 6, lines 54-55) from the second network (also see fig. 2, step 76); therefore, Sturniolo teaches or suggests a mobile device receiving a message informing the device that one or more network identifiers are available for potential handover".

Applicant argued that ""network identification or address" disclosed in Sturniolo is not an identifier for identifying the network" (see REMARKS page 3). Figure 2 of Sturniolo describes a process of handover wherein a mobile station is in the coverage of the first network (step 52) and receives the first network ID (step 54) and then establishes communication with the first network (step 56). When the mobile station

roams into the coverage of the second network (step 74) and receives the second network ID (step 76) and then establishes communication with the second network (step 56). One of ordinary skill in the art can recognize that the specific term “NETWORK IDENTIFICATION" from step 76 (and/or step 54) is an identifier for identifying the network.

With all the explanations of above, it is believed that the cited references disclose all the limitations of independent claims 28, 29, 32 and 33; thus the combination of cited references can be used to reject each and every independent claims 28, 29, 32 and 33.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

I) Claims 28, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618; previously cited) in view of Sturniolo (US 6,201,962; previously cited) and further in view of Daly (US 6,122,503; previously cited).

Regarding claim 28, Lynch discloses a method for user equipment (fig. 1, 12) for a mobile communication system (fig. 1, 10) comprising:

receiving a message on said user equipment including a first list of a plurality of network identifiers (“stored preferred SID list”; col. 12, lines 1-8) that are available for a

potential handover ("hand-off", col. 12, lines 1-5), said receiving from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

comparing ("compared", col. 12, lines 1-5) the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list stored in the equipment ("stored"; col. 12, lines 1-5), said second list including at least one network identifier ("received SIDs"; col. 12, lines 1-5).

But, Lynch does not particularly show wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network. However in analogous art, Sturniolo teaches wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover (col. 6, lines 53-56), and said receiving of said message occurs without said user equipment searching said mobile communication network (col. 6, lines 39-56); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lynch as taught by Sturniolo for purpose of providing an alternative technique in obtaining the network identifier. Since, the user equipment can scan or request (registering) to receive the available network identifier for the potential handoff, the quality of wireless communication service will be more reliable.

But, Lynch and Sturniolo do not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used.

However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lynch and Sturniolo as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 29, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

means for receiving a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-5) of a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

means for comparing ("compared", col. 12, lines 1-5) the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list which includes at least one network identifier ("received SIDs"; col. 12, lines 1-5) and is stored in the user equipment ("stored"; col. 12, lines 1-5).

But, Lynch does not particularly show wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user

equipment searching said mobile communication network. However in analogous art, Sturniolo teaches wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover (col. 6, lines 53-56), and said receiving of said message occurs without said user equipment searching said mobile communication network (col. 6, lines 39-56); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lynch as taught by Sturniolo for purpose of providing an alternative technique in obtaining the network identifier. Since, the user equipment can scan or request (registering) to receive the available network identifier for the potential handoff, the quality of wireless communication service will be more reliable.

But, Lynch and Sturniolo do not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch and Sturniolo as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 33, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

a receiver (fig. 1, 12) for receiving a message that includes a first list of a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-5) that are available for a potential handover ("hand-off" see col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

a comparator (fig. 1, 12) for comparing ("compared", col. 12, lines 1-5) the received first list with a second list ("received SIDs"; col. 12, lines 1-5) which includes at least one network identifier and is stored in the user equipment ("stored"; col. 12, lines 1-5).

But, Lynch does not particularly show wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network. However in analogous art, Sturniolo teaches wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover (col. 6, lines 53-56), and said receiving of said message occurs without said user equipment searching said mobile communication network (col. 6, lines 39-56); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lynch as taught by Sturniolo for purpose of providing an alternative technique in obtaining the network identifier. Since, the user equipment can scan or

request (registering) to receive the available network identifier for the potential handoff, the quality of wireless communication service will be more reliable.

But, Lynch and Sturniolo do not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch and Sturniolo as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

II) Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618; previously cited), in view of Sturniolo (US 6,201,962), in view of Daly (US-6,122,503; previously cited) and further in view of Grandhi (US 6,125,280; previously cited).

Regarding claim 32, Lynch discloses a mobile communications network (fig. 1, 10) or component (fig. 1, 12) thereof including:

means for receiving by a user equipment (fig. 1, 12) a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-5) of a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-5), from the

communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5);

means for comparing ("compared", col. 12, lines 1-5) by the user equipment the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list which includes at least one network identifier from the plurality of network identifiers ("received SIDs"; col. 12, lines 1-5) and is internally stored in the user equipment ("stored"; col. 12, lines 1-5); and

means for receiving from user equipment communicating with the network an indication of a preferred other network (fig. 5, step 507-510 and col. 11, lines 7-20).

But, Lynch does not particularly show wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network. However in analogous art, Sturniolo teaches wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover (col. 6, lines 53-56), and said receiving of said message occurs without said user equipment searching said mobile communication network (col. 6, lines 39-56); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lynch as taught by Sturniolo for purpose of providing an alternative technique in obtaining the network identifier. Since, the user equipment can scan or request (registering) to receive the available network identifier for the potential handoff, the quality of wireless communication service will be more reliable.

But, Lynch and Sturniolo do not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch and Sturniolo as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Lynch, Sturniolo and Daly do not particularly show means for supplying to the user equipment neighboring cell information for the preferred other network based on the indication. However in analogous art, Grandhi teaches means for supplying neighboring cell information for the preferred other network based on the indication ("provides automatic identification of neighbor cells, and configuration of neighbor cell information"; see col. 3, lines 19-23); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network of Lynch, Sturniolo and Daly as taught by Grandhi in order to improve the handoff process in the wireless communication system, since Grandhi specifically discloses that "Handoff processes use neighbor information to help decide the most appropriate sector or cell to serve a call" (col. 1, lines 53-58).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY PHAN whose telephone number is 571-272-7924. The examiner can normally be reached on 9AM-730PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Huy Q Phan/
Primary Examiner, Art Unit 2617
Date : 03/26/2010